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Dominik Eisert

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EXAMINER

NGUYEN, JOSEPH H

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/523,551	Applicant(s) EISERT ET AL.	
	Examiner JOSEPH NGUYEN	Art Unit 2815	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/22/07, 11/13/06, 11/10/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-13 and 28-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 12-13 and 28-29, it is not understood what it is applicant regards as “the layer coupled to the first main area of the multilayer structure has a degree of reflection of at least 70% or at least 85% because with what respect the degree of the reflection refers to is not defined herein.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 12 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Lester (U.S. Patent No. 6,291,839)

Regarding claim 1, Lester discloses in figure 5 a radiation (light) emitting semiconductor component with a multilayer structure 16, 14, 8 based on GaN (column 2, line 9), which contains an active radiation (light) generating layer 14 and has a first main area (bottom surface of element 8) and a second main area (upper surface of element 16) remote from the first main area for coupling out the radiation generating in the active radiation generating layer 14, wherein the first main area of the multilayer structure is coupled to a reflective layer 9 via the substrate, and the region 16 of the multilayer structure that adjoins the second main area of the multilayer structure is patterned one dimensionally.

It is noted that the term "thin film" is a broad limitation herein because there is no recitation of how thin this thin film is in specific. Therefore, the film disclosed by Lester in figure 5 can be construed as "thin film".

Regarding claim 2, Lester discloses in figure 5 the region 16 of the multilayer structure that adjoins the second main area of the multilayer structure has convex elevations.

Regarding claims 3-4, Lester discloses in figure 5 the elevation 16 has the form of truncated cones or cones.

Regarding claim 12, as best understood, Lester discloses in figure 5 the layer 9 coupled to the first main area of the multilayer structure has a degree of reflection at

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least 70% (column 2, lines 65-66). It is assumed herein that the degree of reflection is with respect to the normally incident visible light.

Regarding claim 14, Lester discloses in figure 5 the multilayer structure is applied by its first main area directly on a carrier substrate (substrate). It is noted that the substrate as shown in figure 5 can function as "carrier substrate" because it is connected to conductive layer 9, which enables the substrate to electrically connect with the electrical source or circuit to drive the light emitting device.

Regarding claim 15, Lester discloses in figure 5 the reflective layer 9 is also a conductive layer which can serve as a contact area of the semiconductor component.

Regarding claim 16, Lester discloses in figure 5 a conductive transparent layer 20 (column 3, lines 41-48) is applied on the second main area of the multilayer structure.

Claims 18-19 and 30-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Thibeault et al. (U.S. 6,410,942).

Regarding claims 18-19, Thibeault et al. discloses in figure 3 a radiation emitting thin film semiconductor component with a multilayer structure base on GaN (column 6, lines 31-33), which contains an active radiation generating layer and has a first main area (interface area between layer 40 and the layer right below it) and a second main area (interface area between first spreader and the layer right above it) remote from the first main area for coupling out the radiation generated in the active, radiation generating layer, wherein the first main area of the multilayer structure is coupled to a

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reflective layer 42 and a transparent layer 40 is provided between the first main area of the multilayer structure and the reflective layer, said transparent layer being patterned one dimensionally.

It is noted that layer 40 is formed of NiO/Au (column 7, lines 24-25), which is a transparent conductive material.

Regarding claim 30, Thibeault et al. discloses in figure 3 the reflective layer 42 is applied on a carrier substrate 46.

Regarding claim 31, Thibeault et al. discloses in figure 3 the reflective layer can serve as a contact area of the semiconductor component.

Claims 18-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Camras et al. (U.S. Patent No. 7,064,355).

Regarding claims 18-19, in a similar manner, Camras discloses in figure 4 all the structure set forth in claims 18-19. See columns 5-6.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lester.

Regarding claim 5, Lester discloses in figure 5 the elevations 16 have the form of truncated cones, not of a circle segment cross sectional form as claimed. However, In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966), the Court held that the changes in shape was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence (MPEP 2144.04, page 2100-137, Rev. 5, August, 2006). Therefore, it would have been obvious at the time of the present invention to modify Lester by including the elevation having the circle segment cross sectional form, since this involves only routine skill in the art.

Regarding claims 6-7, Lester discloses in figure 5 the elevations have an aperture angle of certain degree(s), not necessarily between approximately 30° and approximately 70° or between approximately 40° and approximately 50°. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lester by including the elevations having an aperture angle of between approximately 30° and approximately 70° or between approximately 40° and approximately 50°, since it has been held that where the general conditions of a claim are disclosed in the prior art discovering the optimum or working ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Regarding claim 8, Lester discloses in figure 5 the elevations 16 have certain heights. Lester does not disclose the height of the elevations being at least as large as the height of the plane region of the multilayer structure between the active, radiation

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generating layer and the elevations. However, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Lester by including the height of the elevations being at least as large as the height of the plane region of the multilayer structure between the active, radiation generating layer and the elevation, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 9, Lester discloses in figure 5 the elevations 16 have certain heights. Lester does not disclose the height of the elevations being approximately twice as large as the height of the plane region of the multilayer structure between the active, radiation generating layer and the elevations. However, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Lester by including the height of the elevations being approximately twice as large as the height of the plane region of the multilayer structure between the active, radiation generating layer and the elevation, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 10, Lester discloses in figure 5 the elevations have grid dimension. Lester does not disclose the grid dimension of the elevations being at most approximately five times as large as the height of the elevations. However, it would

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have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Lester by including the grid dimension of the elevations being at most approximately five times as large as the height of the elevations, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 11, Lester discloses in figure 5 the elevations have grid dimension. Lester does not disclose the grid dimension of the elevations being at most approximately three times as large as the height of the elevations. However, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Lester by including the grid dimension of the elevations being at most approximately three times as large as the height of the elevations, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 13, Lester discloses in column 2, lines 65-67 the layer 9 coupled to the first main area of the multilayer structure has a degree of reflection of greater than 70%. Lester, however, does not exclusively disclose the degree of reflection of at least 85%. Nevertheless, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Lester by including the layer coupled to the first main area of the multilayer structure having a degree of reflection of at least 85%, since it has been held that discovering an optimum

value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lester in view of Yamazaki et al. (U.S. Patent No. 6,515,310).

Regarding claim 17, Lester discloses in figure 5 substantially all the structure set forth in claim 17 except a transparent protective layer being applied on the second main area of the multilayer structure. However, Yamazaki et al. disclose in figure 3A a semiconductor device comprises a transparent protective layer 305 applied on top surface of the multilayer structure to protect the device. In view of such teaching, it would have been obvious at the time of the present invention to modify Lester by including a transparent protective layer being applied on the second main area of the multilayer structure to protect the device.

Claims 20-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thibeault et al.

Regarding claim 20, Thibeault et al. discloses in figure 3 the transparent layer 40 has elevations with certain shape. Lester does not disclose the elevations being the convex elevations. However, In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966), the Court held that the changes in shape was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence (MPEP 2144.04, page 2100-137, Rev. 5, August, 2006). Therefore, it would have been obvious

at the time of the present invention to modify Thibeault et al. by including the elevation having the convex elevations, since this involves only routine skill in the art.

Regarding claim 21, Thibeault et al. discloses in figure 3 the transparent layer 40 has elevations with certain shape. Lester does not disclose the elevations having the form of truncated cones. However, In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966), the Court held that the changes in shape was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence (MPEP 2144.04, page 2100-137, Rev. 5, August, 2006). Therefore, it would have been obvious at the time of the present invention to modify Thibeault et al. by including the elevations having the form of truncated cones, since this involves only routine skill in the art.

Regarding claims 22-23, Thibeault et al. discloses in figure 3 the elevations have an aperture angle of certain degree(s), not necessarily between approximately 30° and approximately 70° or between approximately 40° and approximately 50°. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Thibeault et al. by including the elevations having an aperture angle of between approximately 30° and approximately 70° or between approximately 40° and approximately 50°, since it has been held that where the general conditions of a claim are disclosed in the prior art discovering the optimum or working ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Regarding claim 24, Thibeault et al. discloses in figure 3 the elevations 16 have certain heights. Lester does not disclose the height of the elevations being at least as

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large as the height of the plane region of the multilayer structure between the active, radiation generating layer and the elevations. However, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Thibeault et al. by including the height of the elevations being at least as large as the height of the plane region of the multilayer structure between the active, radiation generating layer and the elevation, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 25, Thibeault et al. discloses in figure 3 the elevations 40 have certain heights. Thibeault et al. does not disclose the height of the elevations being approximately twice as large as the height of the plane region of the multilayer structure between the active, radiation generating layer and the elevations. However, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Thibeault et al. by including the height of the elevations being approximately twice as large as the height of the plane region of the multilayer structure between the active, radiation generating layer and the elevation, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 26, Thibeault et al. discloses in figure 3 the elevations have grid dimension. Thibeault et al. does not disclose the grid dimension of the elevations being

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at most approximately five times as large as the height of the elevations. However, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Thibeault et al. by including the grid dimension of the elevations being at most approximately five times as large as the height of the elevations, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 27, Thibeault et al. discloses in figure 3 the elevations have grid dimension. Lester does not disclose the grid dimension of the elevations being at most approximately three times as large as the height of the elevations. However, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Thibeault et al. by including the grid dimension of the elevations being at most approximately three times as large as the height of the elevations, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claims 28-29, Thibeault et al. discloses the layer 42 (column 7, lines 18-20) coupled to the first main area of the multilayer structure has a certain degree of reflection. Thibeault et al. does not disclose the degree of reflection of at least 70% or 85%. Nevertheless, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Thibeault et al. by including the layer coupled to the first main area of the multilayer structure having a degree of reflection of

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at least 70% or at least 85%, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thibeault et al. in view of Yamazaki et al. (U.S. Patent No. 6,515,310).

Regarding claim 32, Thibeault et al. discloses in figure 3 substantially all the structure set forth in claim 32 except a transparent protective layer being applied on the second main area of the multilayer structure. However, Yamazaki et al. disclose in figure 3A a semiconductor device comprises a transparent protective layer 305 applied on top surface of the multilayer structure to protect the device. In view of such teaching, it would have been obvious at the time of the present invention to modify Thibeault et al. by including a transparent protective layer being applied on the second main area of the multilayer structure to protect the device.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Nguyen whose telephone number is (571) 272-1734. The examiner can normally be reached on Monday-Friday, 8:30 am- 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ken Parker can be reached on (571) 272-2298. The fax phone number for

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the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J. N./
/Jerome Jackson Jr./
Primary Examiner, Art Unit 2815